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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,495	10/15/2003	Takeshi Mori	NPR-128	3509
20374	7590	11/15/2005		
KUBOVCIK & KUBOVCIK SUITE 710 900 17TH STREET NW WASHINGTON, DC 20006			EXAMINER AHMED, AAMER S	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/684,495

Applicant(s)

MORI ET AL.

Examiner

Aamer S. Ahmed

Art Unit

3763

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5,7,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group A:      Figures 1 and 3

Group B:      Figure 4

Group C:      Figure 5

Group D:      Figure 7

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Ronald Kubovcik on August 26, 2005 a provisional election was made without traverse to prosecute the invention of Group a Figures 1 and 3, claims 1-4, 6 and 8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5, 7 and 9-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract uses excessive legal phraseology, such as "means". Correction is required. See MPEP § 608.01(b).

***Specification***

Claims 1-4 and 6 contain means plus function language. The examiner takes the position that the applicant is invoking 112 sixth paragraph and the means described are the means described in the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell U.S. Patent Number 2,471,623 in view of Berrigan U.S. Patent Number 6,319,245. Hubbell ('623) discloses a liquid infusion apparatus for infusing a liquid medicine comprising a liquid medicine pressurizing/supplying rubber elastic body (B), exerting pressure on a liquid medicine

and causing the liquid medicine to flow through a first passage (X) and a secondary liquid medicine pressuring spring component (C) connected in liquid communication with the liquid medicine pressurizing/supplying rubber elastic body (B) by the first passage (X) and which is sized to receive an increment of liquid medicine from the liquid medicine pressurizing/supplying rubber elastic body (B) and which exerts a pressure on the liquid medicine that is lower than the pressure exerted on the liquid medicine by the liquid medicine pressurizing/supplying means (B), see figure 1.

Hubbell ('623) fails to disclose that the liquid medicine infusion apparatus comprises opening/closing clamps.

Berrigan ('245) discloses a similar medicine infusion device comprising upstream opening/closing means (21) arranged in the first passage (20), for opening and closing the liquid communication state between the liquid medicine pressurizing/supplying means and the secondary liquid pressurizing means (16); downstream opening/closing means (24) arranged in a second passage (22) connected to and provided downstream of the secondary pressurizing means (16); and control means (27) for controlling the opening/closing timing the upstream opening/closing (21) means and of the downstream opening/closing means (24), see figure 1.

It would have been obvious to one having ordinary skill in the art at the time of the invention by applicant to modify the apparatus of Hubbell ('623) by adding the opening/closing means as well as the control means, as taught by Berrigan ('245), in order to permit unidirectional flow to the pump and delivery reservoir (col. line 60).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell ('623) and Berrigan ('245) and further in view of Burke et al U.S. Patent Number 4,038,982. Hubbell

('623) and Berrigan ('245) disclose the apparatus as described above in reference to claim 1.

Neither Hubbell ('623) nor Berrigan ('245) disclose an electromagnetic valve.

Burke et al ('982) discloses a similar infusion device comprising an electromagnetic valve (27); see figure 3 and col. 3 line 45.

It would have been obvious to one having ordinary skill in the art at the time of the invention by applicant to modify the apparatus of Hubbell ('623) and Berrigan ('245) by adding the electromagnetic valve as taught by Burke et al ('982) in order control the fluid flow (see abstract).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5318540 A	Athayde; Amulya L. et al.
US 5492534 A	Athayde; Amulya L. et al.
US 6837876 B2	Bally; Christoph A. et al.
US 4995864 A	Bartholomew; Victor L. et al.
US 3661189 A	Bowser; Gary L. et al.
US 6604908 B1	Bryant; Robert J. et al.
US 5067943 A	Burke; Paul
US 5088983 A	Burke; Paul
US 5551849 A	Christiansen; Chris C.
US 4886499 A	Cirelli; Giorgio et al.
US 4714462 A	DiDomenico; Robert A.
US 4299220 A	Dorman; Frank D.
US 6907879 B2	Drinan; Darrel et al.
US 5346477 A	Edwards; Floyd V. et al.
US 20010049486 A1	Evans, Michael A. et al.
US 20030216684 A1	Fentress, James K. et al.
US 5921233 A	Gold; Scott et al.
US 5090963 A	Gross; Joseph et al.
US 6090070 A	Hager; Jorg-Christian et al.
US 6520937 B2	Hart; Colin P. et al.
US 20010031947 A1	HERUTH, KENNETH T.
US 6394981 B2	Heruth; Kenneth T.
EP 1254676 A1	HIEJIMA, KATSUHIRO
US 5514096 A	Hiejima; Katsuhiko
US 5925023 A	Hiejima; Katsuhiko
US 6554805 B2	Hiejima; Katsuhiko
US 5839470 A	Hiejima; Katsuhiko et al.

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US 5931193 A	Hiejima; Katsuhiro et al.
US 6139530 A	Hiejima; Katsuhiro et al.
US 6213981 B1	Hiejima; Katsuhiro et al.
US 5356375 A	Higley; Robert E.
US 4090514 A	Hinck; Howard Helmut et al.
US 5735824 A	Hjertman; Birger
US 6475182 B1	Hnojewyj; Olexander et al.
US 5497912 A	Hoback; Michael W. et al.
US 5810202 A	Hoback; Michael W. et al.
US 3875979 A	Hults; Wayne P.
US 6913591 B2	Itoh; Takehito et al.
US 5785688 A	Joshi; Ashok V. et al.
US 5445616 A	Kratoska; Paul S. et al.
US 6391006 B1	Kriesel; Marshall S et al.
US 5993425 A	riesel; Marshall S.
US 6056724 A	acroix; Jean-Pierre
US 5059182 A	aing; David H.
US 5399166 A	aing; David H.
US 20030208158 A1	Lampropoulos, Fred P. et al.
US 4507116 A	Liebinsohn; Saul
US 20030040709 A1	Mason, Jeffrey T.
US 5439452 A	McCarty; Read S.
US 4354492 A	McPhee; Charles J.
US 4043332 A	Metcalf; Harold J.
US 6890320 B2	Minezaki; Susumu
US 4256104 A	Muettertities; Andrew J. et al.
US 5935100 A	Myers; Jan Willem Marinus
US 6527521 B2	Noda; Hiroyuki
US 5810765 A	Oda; Hideo
US 6056727 A	O'Neil; Alexander George Brian
US 6206850 B1	O'Neil; Alexander George Brian
US 3572556 A	Pogacar; Peter
US 5015226 A	Polaschegg; Hans-Dietrich
US 5112303 A	Pudenz; Robert H. et al.
US 6251098 B1	Rake; Kenneth W. et al.
WO 2083209 A1	RAMEY, KIRK
US 6854620 B2	Ramey; Kirk
US 5061242 A	Sampson; Edward J.
US 5578005 A	Sancoff; Gregory E. et al.
US 5009635 A	carberry; Eugene N.
US 20010009994 A1	Small, James R. et al.
US 4596558 A	Smith; Timothy J. N. et al.
US 5308322 A	Tennican; Patrick O. et al.
US 5569208 A	Woelpper; William R. et al.
US 6558346 B1	Yoshioka; Wataru et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aamer S. Ahmed whose telephone number is 571-272-5965. The examiner can normally be reached on Monday thru Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.A.



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